

Received Event (Event Succeeded)

Date: 7/23/99
Pages: 15
Sender: 914 945 4073

Time: 1:14 PM
Duration: 5 min 4 sec
Fax Number:

JUL 23 '99 13:33 FR OO-IBM YORKTOWN

914 945 4073 TO 917033053599

P.11/15

AD
isopropanol, ethanol, water, dimethylpropylene urea, gamma butyrolactone, diethylether, benzene, toluene, chloroform, tetrahydrofuran, heptanone, pentanones, and combinations thereof.

Remarks

Reconsideration is respectfully requested in view of any changes to the claims and the remarks herein. Please contact the undersigned to conduct a telephone interview in accordance with MPEP 713.01 to resolve any remaining requirements and/or issues prior to sending another Office Action. Relevant portions of MPEP 713.01 are included on the signature page of this amendment.

The specification has been amended to move the tables of pages 29-31 to page 22. The specification at page 11 has been corrected as indicated by the Examiner.

Claims 1-19 have been rejected under 35 USC 112, first paragraph. The Examiner states the "recited process of polymerizing monomers in the presence of a fluorinated solvent in various claims clearly lacks antecedent basis in the specification". Applicants respectfully disagree. Only claims 6 and 7 make such recitation. Although the Examiner has rejected claims 1-19 under 35 USC 112, first paragraph, the Examiner has only given specific comments in regard to claim 3. The Examiner's general comment that the "specification ... does not reasonably provide enablement for polymerizing monomers in the presence of a fluorinated solvent" can only apply to claims 6 and 7 which are the only claims which recite this limitation. Thus claims 1-2, 4-5, and 8-19 can not be rejected under 35 USC 112, first paragraph. At page 11, lines 7-8, two co-pending US applications are incorporated by reference. These applications teach polymerizing monomers the presence of a solvent. The present application teaches using a fluorine containing solvent. The paragraph bridging pages 18 and 19 of the present specification teach polymerizing monomers in the presence of a solvent. Thus claims 6 and 7 are enabled.

The examiner states that "substituted" in claim 3 is not commensurate in scope with the enabling disclosure. Applicants respectfully disagree. Substituted conductive polymer and polymers and precursors thereof are well known. See for example US Patents 5,160,457 and 5,198,153. US

Received Event (Event Succeeded)

Date: 7/23/99
Pages: 15
Sender: 914 945 4073

Time: 1:14 PM
Duration: 5 min 4 sec
Fax Number:

JUL 23 '99 13:34 FR OO-IBM YORKTOWN

914 945 4073 TO 917033053599

P.12/15

Patent 5,198,153 is incorporated by reference in the specification at page 9, line 15. Therefore, guidelines are present in the specification to enable a person of skill in art to practice the claimed invention with "substitute" electuallly conductive polymers and precursors thereof as claimed by applicants.

In view of the changes to the claims and the remarks herein, withdrawal of the rejection of claims 1-19 under 35 USC 112, first paragraph is respectfully requested.

Claims 1-19 have been rejected under 35 USC 112, second paragraph. As indicated above applicant's specification teaches polymerizing monomers in the presence of a solvent, such as fluorine containing solvents. Claims 6 and 7 are the only claims making such a recitation.

Claims 7, 14, 15, 17 and 18 has been amended to correct the language as indicated by the Examiner.

The recitation of " $x \geq 2$ " has been eliminated from claims 14 and 15.

In view of the changes to the claims and the remarks herein withdrawal of Claims 1-12 and 16-19 have been rejected under 35 USC 102(b) as anticipated or under 35 USC 103(a) as obvious over Jonas et al. The rejection of claims 1-19 under 35 USC 112, second paragraph is respectfully requested.

Claims 1-4, 9-12, 17 and 18 have been rejected under 35 USC 102(b) as anticipated or under 35 USC 103(a) as obvious over Traynor et al.

Claims 1-4, 6, 7, 9-12 and 16-19 have been rejected under 35 USC 102(b) or 35 USC 103(a) as obvious over Ikenaga et al.

Claims 1-4, 9-15 and 17-19 have been rejected under 35 USC 102(e) as anticipated or under 35 USC 103(a) as obvious over Tan.

Received Event (Event Succeeded)

Date: 7/23/99
Pages: 15
Sender: 914 945 4073

Time: 1:14 PM
Duration: 5 min 4 sec
Fax Number:

JUL 23 '99 13:34 FR OO-IBM YORKTOWN

914 945 4073 TO 917033053599

P.13/15

Claims 1-4, 6, 7 and 9-18 have been rejected under 35 USC 102(b) as anticipated or under 35 USC 103(a) as obvious over EP 0315514.

Independent claim 1, 6, and 7 have been amended to recite "said polymer in said solvent characterized by a dependence of the electrical conductivity of said electrical conductive polymer on the concentration of said polymer in said solvent, said concentration being selected to substantially maximize said electrical conductivity," support for which can be found throughout the specification, in particular at page 20, lines 14-26 of the specification. None of the applicants' cited references teach, suggest, prove motivation for or incentive for claims as amended. In view thereof withdrawal of the rejections of the claim under 35 USC 102, 103 is respectfully requested.

In view of the changes to the claims and the remarks herein, the Examiner is respectfully requested to reconsider the above-identified application. If the Examiner wishes to discuss the application further, or if additional information would be required, the undersigned will cooperate fully to assist in the prosecution of this application.

Please charge any fee necessary to enter this paper and any previous paper to deposit account 09-0468.

If the above-identified Examiner's Action is a final Action, and if the above-identified application will be abandoned without further action by applicants, applicants file a Notice of Appeal to the Board of Appeals and Interferences appealing the final rejection of the claims in the above-identified Examiner's Action. Please charge deposit account 09-0468 any fee necessary to enter such Notice of Appeal.

In the event that this amendment does not result in allowance of all such claims, the undersigned attorney respectfully requests a telephone interview at the Examiner's earliest convenience.

MPEP 713.01 states in part as follows:

Received Event (Event Succeeded)

Date: 7/23/99
Pages: 15
Sender: 914 945 4073

Time: 1:14 PM
Duration: 5 min 4 sec
Fax Number:

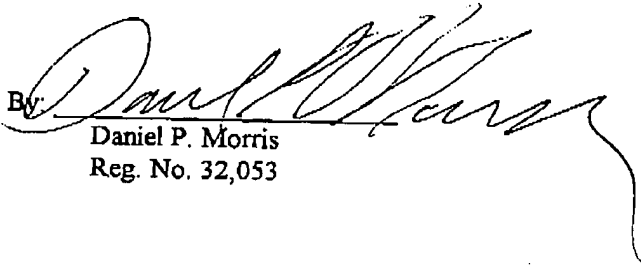
JUL 23 '99 13:34 FR 00-IBM YORKTOWN

914 945 4073 TO 917033053599

P.14/15

Where the response to a first complete action includes a request for an interview or a telephone consultation to be initiated by the examiner, ... the examiner, as soon as he or she has considered the effect of the response, should grant such request if it appears that the interview or consultation would result in expediting the case to a final action.

Respectfully submitted,

By: 
Daniel P. Morris
Reg. No. 32,053

IBM Corporation
Intellectual Property Law Dept.
P. O. Box 218
Yorktown Heights, New York 10598
Telephone No.: (914) 945-3217